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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,011	12/30/2005	Su-Jong Kim	Q88593	7384
23373	7590	11/16/2007	EXAMINER	
SUGHRUE MION, PLLC			HENRY, MICHAEL C	
2100 PENNSYLVANIA AVENUE, N.W.			ART UNIT	PAPER NUMBER
SUITE 800			1623	
WASHINGTON, DC 20037				

  

MAIL DATE	DELIVERY MODE
11/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/539,011	KIM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael C. Henry	1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>06/15/05 &amp; 09/16/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

Claims 1-4 are pending in application

### ***Information Disclosure Statement***

The information disclosure statement filed complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Claim 1 does not end with a period. However, each claim should begin with a capital letter and end with a period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by IL HWA CO., LTD (KR 2003-0065273, Abstract Only).

Claim 1 is drawn to a promoter for the production of hyaluronic acid containing compound K (20-O-13-D-glucopyranosyl-20(S)-protopanaxadiol) represented by a given formula 1 as an effective ingredient. IL HWA CO., LTD (KR 2003-0065273) disclose applicant's composition containing said compound K (20-O-13-D-glucopyranosyl-20(S)-protopanaxadiol) (see abstract). It should be noted that IL HWA CO., LTD composition or

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product has the same effective or active ingredient as applicant's composition or product and should inherently have the same effect or property of being a promoter for the production of hyaluronic acid. Furthermore, it should be noted that applicant does not claim any other ingredient in their said composition or product that is different form that in IL HWA CO., LTD's composition or product. In addition it should be noted that it is well settled that "intended use" of a composition or product, e.g., a promoter for the production of hyaluronic acid, does not further limit claims drawn to a composition or product. See, e.g., *Ex parte Marsham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. Claim 2 is drawn to said composition or product according to Claim 1, wherein said compound K promotes the production of hyaluronic acid by increasing the expression of hyaluronic acid synthase gene. HWA CO., LTD (KR 2003-0065273) disclose applicant's composition containing said compound K (20-O-13-D-glucopyranosyl-20(S)-protopanaxadiol) (see abstract). It should be noted that IL HWA CO., LTD composition or product has the same effective or active ingredient as applicant's composition or product and should inherently have the same effect or property of being a promoter for the production of hyaluronic acid by increasing the expression of hyaluronic acid synthase gene. Furthermore, it should be noted that applicant does not claim any other ingredient in their said composition or product that is different form that in IL HWA CO., LTD's composition or product. In addition it should be noted that it is well settled that "intended use" of a composition or product, e.g., a promoter for the production of hyaluronic acid, does not further limit claims drawn to a composition or product. See, e.g., *Ex parte Marsham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. Claim 3 is drawn to an anti-osteoarthritis agent containing the promoter for the production of hyaluronic acid according to Claim 1. HWA CO.,

LTD (KR 2003-0065273) disclose applicant's composition containing said compound K (20-O-13-D-glucopyranosyl-20(S)-protopanaxadiol) (see abstract). It should be noted that IL HWA CO., LTD composition or product has the same effective or active ingredient as applicant's composition or product and should inherently have the same effect or property of being an anti-osteoarthritis agent. Furthermore, it should be noted that applicant does not claim any other ingredient in their said composition or product that is different form that in IL HWA CO., LTD's composition or product. In addition it should be noted that it is well settled that "intended use" of a composition or product, e.g., an anti-osteoarthritis agent, does not further limit claims drawn to a composition or product. See, e.g., *Ex parte Marsham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. Claim 4 is drawn to an anti-aging agent containing the promoter for the production of hyaluronic acid according to Claim 1. HWA CO., LTD (KR 2003-0065273) disclose applicant's composition containing said compound K (20-O-13-D-glucopyranosyl-20(S)-protopanaxadiol) (see abstract). IL HWA CO., LTD disclose that their composition can be used to inhibit aging (i.e., an anti-aging agent) (see abstract). It should be noted that IL HWA CO., LTD composition or product has the same effective or active ingredient as applicant's composition or product and should inherently have the same effect or property of being an anti-aging agent. Furthermore, it should be noted that applicant does not claim any other ingredient in their said composition or product that is different form that in IL HWA CO., LTD's composition or product. In addition it should be noted that it is well settled that "intended use" of a composition or product, e.g., an anti-osteoarthritis agent, does not further limit claims drawn to a composition or product. See, e.g., *Ex parte Marsham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. Furthermore, it should be noted that the above rejection is made under 35

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U.S.C. 102(a) because applicant's claim to foreign priority over Korean 10-2002-0084036 (12/26/2002) has not been perfected, since an English translation of the said foreign priority document is not filed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 571-272-0652. The examiner can normally be reached on 8.30am-5pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael C. Henry

  
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Shaojia Anna Jiang, Ph.D.  
Supervisory Patent Examiner  
Art Unit 1623

November 13, 2007.